

Appl. No. : 10/646,333
Filed : August 22, 2003

REMARKS

Claims 124-173 are pending in this application. Claims 1-123 have been canceled. New Claims 124-173 have been added. Support for the new claims is found in the specification and claims as filed.

New claims 124-173 correspond to claims 1, 2, 7, 8, 10, 12, 15, 17, 31-63, and 68-76 as filed, except that new independent claims 124, 168, 169, and 171-173 include additional limitations not recited in the corresponding claims as filed.

Claim Rejection - 35 U.S.C. §102(b)

Claims 1, 9, 10, 12, 15, 36, 41, 44-60, 67, 68, 70, 72, and 74-76 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. 5,833,603 to Kovacs et al. Claims 1, 9, 10, 12, 15, 36, 41, 44-60, 67, 68, 70, 72, and 74-76 have been canceled without prejudice, and Applicants now pursue new Claims 124-173. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claims 124, 168, and 171-173, and their corresponding dependent claims, possess novelty over Kovacs et al., which neither teaches nor suggests a sensor comprising, *inter alia*, “a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth.” “A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *See, e.g., In re Paulsen*, 31 U.S.P.Q.2d 1671 (Fed. Cir. 1994). Kovacs et al. only teaches a gas or ion selective permeable membrane that does not support tissue ingrowth.

Pending Claim 167 possesses novelty over Kovacs et al., which neither teaches nor suggests a sensor comprising, *inter alia*, “a major surface compris[ing] a continuous curvature substantially across the entire surface.” Kovacs et al. only teaches sensor wherein the major surface does not comprise a continuous curvature, but is instead substantially flat.

Pending Claim 169 possesses novelty over Kovacs et al., which neither teaches nor suggests a sensor comprising, *inter alia*, “an electrochemical sensing region located on the first major surface that is spaced away from the rounded edges.” Kovacs et al. only teaches a sensor wherein electrodes are situated on an end of an electrochemical sensor, not on a major surface (see Figures 2-10 of Kovacs et al.).

Accordingly, Applicants respectfully request the rejection be withdrawn.

Appl. No. : 10/646,333
Filed : August 22, 2003

Claim Rejection - 35 U.S.C. §102(b)

Claims 1, 7, 67, and 69 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. 6,049,727 to Crothall. Claims 1, 7, 67, and 69 have been canceled without prejudice, and Applicants now pursue new Claims 124-173. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims possess novelty over Crothall, which neither teaches nor suggests a sensor comprising, *inter alia*, “a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth.” Crothall only teaches wire screening to prevent tissue from squeezing into the sensor chamber (see col. 17, lines 62-67 of Crothall).

Accordingly, Applicants respectfully request the rejection be withdrawn.

Claim Rejection - 35 U.S.C. §103(a)

Claims 2 and 7 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. 5,833,603 to Kovacs et al. in view of U.S. Publ. No. 2003/0125613 to Enegren et al. Claims 2 and 7 have been canceled without prejudice, and Applicants now pursue new Claims 124-173. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims are nonobvious over Kovacs et al. and Enegren et al., neither of which teaches or suggests a sensor comprising, *inter alia*, “a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth.” To articulate a *prima facie* case of obviousness under 35 U.S.C. §103(a), the PTO must, *inter alia*, cite prior art that teaches or suggests all the claimed limitations. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Enegren et al. discloses no porous biointerface material for use with the disclosed sensors, much less a material supporting tissue ingrowth, and thus does not address the deficiencies of Kovacs et al.

Accordingly, Applicants respectfully request the rejection be withdrawn.

Appl. No. : 10/646,333
Filed : August 22, 2003

Claim Rejection - 35 U.S.C. §103(a)

Claims 17, 42, and 43 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. 5,833,603 to Kovacs et al. in view of U.S. 6,454,710 to Ballerstadt et al., and further in view of U.S. 4,197,840 to Beck et al. Claims 17, 42, and 43 have been canceled without prejudice, and Applicants now pursue new Claims 124-173. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims are nonobvious over Kovacs et al., Ballerstadt et al., and Beck et al. Ballerstadt et al. does not disclose a porous biointerface material for use with the disclosed sensors, much less a material supporting tissue ingrowth, and thus does not address the deficiencies of Kovacs et al.

Beck et al., which teaches an implantable magnet, and not an implantable sensor, is both nonanalogous art and not pertinent to any concern associated with Applicants' devices, and thus cannot be relied on as a basis for rejection of the pending claims. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). Beck et al. teaches an implanted permanent magnet including an anchorage grown through by tissue. Beck et al. simply states that one object of the invention is to provide a permanent magnet device for implantation that can be anchored securely in tissue. As discussed in paragraph [0139] of the present application, Applicants' focus is not on merely anchoring an implantable device securely in tissue, but rather in minimizing the variability of function observed in an implanted sensor due to the individual nature of how the

Appl. No. : 10/646,333
Filed : August 22, 2003

surrounding tissue heals around a device. Accordingly, Applicants are concerned with selecting an appropriate geometry for a device that requires transport of analytes *in vivo*, such that the healing of the host tissue around the device is optimized, thereby minimizing variability, increasing transport of analytes, and controlling motion artifact *in vivo*. None of these issues are of interest to Beck et al.

Accordingly, Applicants respectfully request the rejection be withdrawn.

Claim Rejection - 35 U.S.C. §103(a)

Claims 61-63 and 73 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. 5,833,603 to Kovacs et al. in view of U.S. 4,927,407 to Dorman. Claims 61-63 and 73 have been canceled without prejudice, and Applicants now pursue new Claims 124-173. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims are nonobvious over Kovacs et al. and Dorman, neither of which teaches or suggests a sensor comprising, *inter alia*, “a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth.” Dorman discloses no porous biointerface material for use with the disclosed sensors, much less a material supporting tissue ingrowth, and thus does not address the deficiencies of Kovacs et al.

Pending Claim 170 is nonobvious over Kovacs et al. and Dorman, neither of which teaches or suggests a sensor comprising, *inter alia*, a body, wherein “the sensing region is located on a major surface of the body, wherein said major surface comprises a continuous curvature substantially across the entire surface of the body.” Dorman does not teach a device with a sensor, much less a sensor wherein the sensing region is in the recited configuration, and thus does not address the deficiencies of Kovacs et al.

Accordingly, Applicants respectfully request the rejection be withdrawn.

Claim Rejection - 35 U.S.C. §103(a)

Claims 31, 32, 35, and 71 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. 5,833,603 to Kovacs et al. in view of U.S. 6,409,674 to Brockway et al. Claims 31, 32, 35, and 71 have been canceled without prejudice, and Applicants now pursue new Claims 124-173.

Appl. No. : 10/646,333
Filed : August 22, 2003

Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims, and Claim 168 are nonobvious over Kovacs et al. and Brockway et al., neither of which teaches or suggests a sensor comprising, *inter alia*, “a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth.” To articulate a *prima facie* case of obviousness under 35 U.S.C. §103(a), the PTO must, *inter alia*, cite prior art that teaches or suggests all the claimed limitations. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Brockway et al. discloses no porous biointerface material for use with the disclosed sensors, much less a material supporting tissue ingrowth, and thus does not address the deficiencies of Kovacs et al.

Accordingly, Applicants respectfully request the rejection be withdrawn.

Claim Rejection - 35 U.S.C. §103(a)

Claims 33 and 34 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. 5,833,603 to Kovacs et al. in view of U.S. Publ. No. 2003/0114735 to Silver et al. Claims 33 and 34 have been canceled without prejudice, and Applicants now pursue new Claims 124-174. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims are nonobvious over Kovacs et al. and Silver et al., neither of which teaches or suggests a sensor comprising, *inter alia*, “a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth.” To articulate a *prima facie* case of obviousness under 35 U.S.C. §103(a), the PTO must, *inter alia*, cite prior art that teaches or suggests all the claimed limitations. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Silver et al. discloses no porous biointerface material for use with the disclosed sensors, much less a material supporting tissue ingrowth, and thus does not address the deficiencies of Kovacs et al.

Accordingly, Applicants respectfully request the rejection be withdrawn.

Claim Rejection - 35 U.S.C. §103(a)

Claims 37-40 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. 5,833,603 to Kovacs et al. Claims 37-40 have been canceled without prejudice, and Applicants now pursue

Appl. No. : 10/646,333
Filed : August 22, 2003

new Claims 124-173. Applicants reserve the ability to pursue the canceled claims, or similar claims, in one or more continuing patent applications.

Pending Claim 124 and its corresponding dependent claims are nonobvious over Kovacs et al., which neither teaches nor suggests a sensor comprising, *inter alia*, "a porous biointerface material that covers at least a portion of the sensing region and that supports tissue ingrowth." Kovacs et al. only teaches a gas or ion selective permeable membrane that does not support tissue ingrowth.

Accordingly, Applicants respectfully request the rejection be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns that might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 3/21/05

By: 

Rose M. Thiessen
Registration No. 40,202
Attorney of Record
Customer No. 20,995
(619) 235-8550

S:\DOCS\RMTRMT-6551.DOC: 030105